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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,914	09/26/2001	Timothy E. Wood	13768.203	9417

47973	7590	08/25/2005

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ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _07 July 2005_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-4,7-9,11,16,18,21 and 23-25_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-4,7-9,11,16,18,21 and 23-25_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _26 September 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: amendment filed on 02/18/2005 to

application filed on 09/26/2001.

2.   Claims 1-4, 7, 11 and 21 are amended.

3.   Claims 23-25 are added.

4.   Claims 14 and 22 are canceled.

5.   Claims 1-4, 7-9, 11, 16, 18, 21 and 23-25 are pending in the case. Claim 1 is independent

claim.

6.   The rejections of claims 2-4 and 7 under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter, have

been withdrawn in view of the amendment.

Claim Objections

7.   Claims 11 and 21 are objected to because of the following informalities:

Regarding dependent claims 11 and 21, "comprising one or computer-readable media"

has typographical error. Appropriate correction is required.

Examiner assumes that "comprising one or <u>more</u> computer-readable media" is used in

claims 11 and 21.

Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
requirements of this title.

9.   **Claims 11 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is**

directed to non-statutory subject matter.

       Regarding independent claims 11 and 21, the claim language of "one or <u>**more**</u>

<u>computer-readable **media**</u> having computer-executable instructions for implementing the method

of claim 1, <u>the computer-readable **medium**</u> comprising one or more physical storage media", are

not limited to tangible embodiments. In view of Applicant's disclosure, specification pages 9-

10, paragraph [0029], the media is not limited to tangible embodiments, instead being defined as

including both tangible embodiments (e.g., " RAM, ROM, EEPROM, CD-ROM") and intangible

embodiments (e.g., "computer-readable media can be any available media"). As such, the claim

is not limited to statutory subject matter and is therefore non-statutory.

                              Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

        obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

> (b) This application currently names joint inventors. In considering patentability of the claims under 35
> U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the
> time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the
> obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly
> owned at the time a later invention was made in order for the examiner to consider the applicability of 35
> U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11.   **Claims 1-3, 7-8, 11, 18, 25 are rejected under 35 U.S.C. 103(a) as unpatentable**

Over <u>Gao</u> et al., US 2002/0032701 A1, priority filed 09/2000, in view of <u>JS-Examples-353</u>,

"Open Bigger Picture", http://www.js-examples.com/javascript/?id=353, published

06/2000, pages 1-15, <u>JS-Examples-354</u>, "Open New Windows", http://www.js-

examples.com/javascript/?id=354, published 04/2000, pages 1-7, <u>Holbrook</u> et al., US

2002/0152222 A1, provisional filed 11/2000, and Yehuda <u>Shiran</u>, "Scriplet Authoring",

http://www.webreference.com/js/tips/ 991222.html, published 12/1999, pages 1-2.

Regarding independent claim 1, Gao teaches the steps of:

- retrieving the document from the server computer system (Gao, [0032], [0046];

  retrieving the requested HTML document from a server to a client);

- displaying the document on a screen (Gao, [0046]);

- detecting a reference in the document to computer-executable instructions not

  included in the document (Gao, [0046]; detecting a script tag in the HTML document

  that references to a Script source);

- retrieving the computer-executable instructions (Gao, [0048]; retrieving the Script

  program from the server);

- executing the computer-executable instructions to generate a script (Gao, [0048],

  server generating appropriate JavaScript code);

- detecting an event comprising movement of a cursor within certain boundaries to a

  specific region of the screen (Gao, page 3, [0034]; detecting a pointer or mouse over a

  designated text element in the HTML document, causing a text box to appear).

However, Gao does not explicitly disclose the script is a scriptlet; while retrieving the

computer-executable instructions, retrieving event-based content to overlay the document on the

screen when a cursor moves to a defined region on the screen; using a HTML handler to detect

an event; in response to detecting the event, using the HTML handler to pass a parameter to the

scriptlet, informing the scriptlet of the event; using the scriptlet to map the event to content that

is to be retrieved; using the scriptlet to retrieve the content in response to being informed of the

event; using the scriptlet to overlay the content over the displayed document after retrieving the

content, wherein the content is displayed in a new window overlaying the displayed document

and in such a way that the content is displayed even when the document is using frames, a drop-

down list, ActiveX controls or custom controls.

JS-Examples-353 teaches displaying a web page with images, such as http://www.js-

example.com/js/pic1.gif, http://www.js-example.com/js/pic2.gif, (JS-Examples-353, pages 1, 5-

9); clicking one of the image, causing a popup window overlay on the displayed page (JS-

Examples-353, pages 8-15) via javascript code (JS-Examples-353, pages 2-4), comprising the

steps of:

-   retrieving and displaying a web page document, wherein the web page contains

    images (JS-Examples-353; pages 1, 5-9);

-   a script program is used to retrieve event-based content to overlay the document on

    the screen when a cursor clicks to a defined region on the screen (JS-Examples-353;

    pages 1-4; script program used to retrieve event-based content http://www.js-

    examples.com/js/pic3.gif" and "http://www.js-examples.com/js/pic4.gif" into

    "bigPic[1]" and "bigPic[2]" (see page 4) to overlay a popup window on the web page

    when clicking of the cursor within boundaries to specific image on the web page (see

    page 8-15);

-   using a HTML handler to detect an event comprising clicking of the cursor within

    certain boundaries to a specific region of the screen (JS-Examples-353; pages 1, 4, 8-

15; when clicking of the cursor within boundaries to specific image on the web page,

a popup window is displayed over the web page);

- in response to detecting the event, using the HTML handler to pass a parameter to the

script, informing the script of the event (JS-Examples-353; page 4, 8-15; when one of

the images is clicked, the script function showBig(n) is executed);

- using the script to map the event to content that is to be retrieved (JS-Examples-353;

page 4; when one of the images is clicked, for example, image "http://www.js-

example.com/js/pic1.gif" is click, mapping the event showBig(1) to function

showBig(_n) so that a corresponding image "http//:www.js-examples.com/js/pic3.gif"

from bigPic[1] to be retrieved);

- using the script to retrieve the content in response to being informed of the event (JS-

Examples-353; pages 1, 4, 8-15; using the script function to retrieve the

corresponding image "http//:www.js-examples.com/js/pic3.gif" from bigPic[1] in

function openIt (bigPic[_n])); and

- using the script to overlay the content over the displayed document after retrieving

the content (JS-Examples-353; pages 1, 4, 8-15; using the script function to display

the corresponding image "http//:www.js-examples.com/js/pic3.gif" from bigPic[1] in

a popup window over the displayed document).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined JS-Examples_353 into Gao to retrieve the script and the

event-based content when a cursor moves to a defined region on the web page so that text box or

a popup window is displayed when the cursor clicks or moves over an image or designated

element as Gao disclosed in pargraph [0034].

JS-Examples does not explicitly teach a mouse moves over event.

JS-Examples-354 teaches a popup window is displayed when a cursor moves over,

moves out or clicks on a hyperlink (JS-Examples-354, pages 1-7, using "onmouseover",

"onmouseout" HTML handlers).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined JS-Examples-354 into JS-Examples-353 and Gao to

retrieve the event-based content when a cursor moves to a defined region on the web page in the

script program so that a popup window is displayed when the cursor clicks, moves out, or moves

over a hyperlink or image, since the combination would have provided different events to display

the popup window.

However, JS-Examples-354 does not explicitly disclose that the content is displayed even

when the document is using frames, a drop-down list, ActiveX controls or custom controls.

Holbrook teaches help or any desired information are displayed in a popup window in

response to a mouse over a defined element in a web page to help the user understands more

about the element, wherein the web page having frames (Holbrook, [0073]-[0076], [0079],

figures 3-4; displaying a popup window 405 when a mouse moves over "Shopping" category

406).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Holbrook's teaching into JS-Examples-353, JS-Examples-

354 and Gao, since the combination would have displayed the popup window even when the web

page is or is not using frames.

Shiran teaches, "scriptlet is an independent script that is reference from an HTML page to

describe the behavior of an object and the event it is triggered by" as Shiran disclosed in page 1,

first paragraph.

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Shiran's scriptlet into Gao, Homer and JS-Examples,

since the combination would have provided many kind of scripts to provide popup windows

when an event is triggered.

Regarding claim 2, which is dependent on claim 1, Gao teaches retrieving document

from the server computer system comprises the following: a specific act of retrieving a

HyperText Markup Language (HTML) document from the server computer system (Gao, page 3,

paragraph 32; page 4, paragraph 46).

Regarding claim 3, which is dependent on claim 2. Gao teaches wherein detecting a

reference in the document to computer-executable instructions not included in the document

comprises the following: a specific act of the detecting a SCRIPT tag in the HTML document

(Gao, page 4, paragraph 46).

Regarding claim 7, which is dependent on claim 1. Gao discloses wherein the retrieving

content in response to the event comprises the following: a specific act of retrieving *update*

information related to the area of the displayable form of the document over which the pointer

has moved (Gao, page 3, paragraph 34; page 5; paragraph 50). Gao does not explicitly disclose

retrieving *help information*.

Holbrook teaches help or any desired information are displayed in a popup window in

response to a mouse over a defined element/field in a web page to help the user understands

more about the field/element (Holbrook, [0079]).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Holbrook and Gao to provide help, update or desired

information that related to the elements in the web page, since the combination would have

provided more information about the elements on primary web pages without cluttering such

web pages.

Regarding claim 8, which is dependent on claim 1, Gao teaches wherein retrieving the

computer-executable instructions comprises the following: a specific act of retrieving one or

more data structure that represent at least some of the content (Gao, page 3, paragraph 34; page

5; paragraph 50).

Claim 11 is for a computer readable media performing the method of claim 1, and is

rejected under the same rationale.

Regarding claim 18, which is dependent on claim 1, the limitation of "wherein the

HTML handler is an OnMouseOver handler" is addressed. The rationale is incorporated herein.

Regarding claim 25, which is dependent on claim 1, the limitation of "wherein detecting the event comprising movement of the cursor within certain boundaries to a specific region includes detecting movement of the cursor to a region of the screen without detecting movement of the cursor selecting a text element" is addressed and specifically taught by JS-Examples-354, wherein the cursor moves over a hyperlink. The rationale is incorporated herein.

12.   **Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Gao in view of JS-Examples-353, JS-Examples-354, Holbrook and Shiran</u> as applied to claims 1 above and further in view of <u>JS-Examples-503</u>, "DHTML Popup for NS6 and IE5", http://www.js-examples.com/javascript/?id=503, published 03/2001, pages 1-8.**

Regarding claim 24, which is dependent on claim 1, Gao does not explicitly disclose the specific region is a field.

JS-Examples-503 teaches displaying a popup window when the cursor moves over a specific region on a web page, wherein the specific region is a field (JS-Examples-503, pages 1-8, displaying popup windows with "message1" and "message2" when a cursor moves over entry text field "txt1" and "txt2" respectively (see page 4)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined JS-Examples-503 into JS-Examples-353, JS-Examples-354, Holbrook and Gao, since the combination would have provided a popup window with help information when the cursor moves over different objects, such as hyperlink, image, icon, or an entry text field.

13.   **Claims 4, 9, 16, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over <u>Gao in view of JS-Examples-353, JS-Examples-354, Holbrook and Shiran</u> as applied

to claims 1 and 8 above and further in view of <u>Hunt</u> et al., US 2004/0133848 A1, provisional

filed 04/2000.

Regarding claim 4, which is dependent on claim 1. The combination of Gao, Homer and

JS-Examples teaches wherein retrieving the computer-executable instructions comprises the

following: a specific act of retrieving computer-executable instructions that operate the overly a

window over the displayable form of the document, as explained in claim 1 above. The rationale

is incorporated herein.

However Gao does not explicitly disclose overlaying a window over the document *even if*

other windows or frames already overly the displayable form of the document.

Hunt teaches, "a popup window may be closed automatically or it may require the user to

explicitly close it" (Hunt, page 22, paragraph 343).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Hunt popup window's modes into Gao to overlaying a

window over the document during other windows already overly the displayable form of the

document, since the combination would have provided options for display popup windows and

the user controls (closes) what popup window as the user wants/needs.

Regarding claim 9, which is dependent on claim 8, Gao does not explicitly teaches

wherein the retrieving one or more data structure comprises the following: retrieving one or more

data structures that are structured in accordance with the eXtensible Markup Language (XML) format.

Hunt teaches method for providing and displaying information (Hunt's title), using Script to provide popup information for the user in HTML or XML content (Hunt, page 6, paragraph 86; page14, paragraph 177; page 22, paragraph 343).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hunt's XML content into Gao to provide data in XML format, since the combination would have provided both XML or HTML content to be displayed in popup windows for the user.

Regarding claim 16, which is dependent on claim 1, Gao does not explicitly disclose displaying a first window over a portion of the document and displaying a second window over the document during the specific act of displaying the first window over the document.

Hunt teaches, "a popup window may be closed automatically or it may require the user to explicitly close it" (Hunt, page 22, paragraph 343).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hunt popup window's modes into Gao to overlaying a window over the document during other windows already overly the displayable form of the document, since the combination would have provided options for display popup windows and the user controls (closes) what popup window as the user wants/needs.

Claim 21 is for a computer readable media performing the method of claim 16, and is

rejected under the same rationale.

14.   **Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Gao in view</u>**

<u>of JS-Examples-353, JS-Examples-354, Holbrook and Shiran</u> as applied to claim 1 above

and further in view of <u>McCann</u> et al., US. 5,963,939, filed 09/1997.

Regarding claim 23, which is dependent on claim 1. Gao does not teach the content is

displayed in an ActiveX window.

McCann teaches a popup window may be an ActiveX control window (McCann, col.65,

lines 23-33, fig. 51).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined McCann's ActiveX control popup window into Gao and

JS-Examples to provide different formats for a popup window, since the combination would

have provided an HTML or ActiveX popup window for the user.

Response to Arguments

15.   Applicant's arguments with respect to claims 1-4, 7-9, 11, 16, 18, 21 and 23-25 have

been considered but are moot in view of the new ground(s) of rejection.

Applicants argue that cited references fail to disclose or suggest that "the content is

downloaded when the computer-executable instructions are downloaded, and particularly when

the content is displayed overlaying a displayed document, event when the document is using

frames, a drop-down list, ActiveX controls or custom controls".

However, the combination of Gao, JS-Examples-353, JS-Examples-354, Hobrook and

Shiran teaches such limitations as explained in the rejection above.

Applicants argue that cited references fail to disclose or suggest, "detecting a movement

of a cursor to a particular region of the screen, particularly a region other than text, such as a

field".

However, JS-Examples-503 teaches such limitation as explained in the rejection above.

Applicants argue that "[t]he cited disclosure also fails to disclose or suggest that the new

content is displayed in an ActiveX window".

However, McCann suggests the popup window is an ActiveX control window as

explained in the rejection above.

Conclusion

16.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Foulkes et al., US 6,519,643 B1, filed 04/1999, teaches method for a session allocation.

Bruce, http://www.uea.ac.uk/~k045/interactive/javascript/popup.html, pages 1-2,

copyright 01/1999.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thu V Huynh whose telephone number is (571) 272-4126. The

examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen S Hong can be reached on (571) 272-4124. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

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TVH
August 18, 2005

WILLIAM BASHORE
PRIMARY EXAMINER
8/21/2005